



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/910,716

07/24/2001

Hiroaki Harada

1344.1071

1801

21171 7590 10/13/2010

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

RAPILLO, KRISTINE K

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

10/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/910,716	Applicant(s) HARADA ET AL.	
	Examiner KRISTINE K. RAPILLO	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/16/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 10, 11 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10-11 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/13/2009; 8/5/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3626

DETAILED ACTION

Notice to Applicant

1. This communication is in response to an amendment submitted August 16, 2010. Claims 1, 6 – 9, 12 – 19, and 21 – 22 were previously canceled. Claims 4 – 5, 10 11, and 20 are amended. Claims 2 – 5, 10 – 11 and 20 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 2 - 5, 10 - 11, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. With regard to claim 4, the following limitations are rejected as being vague and indefinite:
 - The phrase “judging whether the solicitation-related keyword” is condition; the claims allows the options of *found the keyword* or *has not found the keyword*. For the purpose of examination, the claim will be treated as the keyword has not been found. In addition, it is unclear who or what is performing the step of judging.
 - The limitation “selecting at least one insurer from a plurality of insurers based on registered information that satisfies a providing condition of a trading price and a transaction type indicating whether the transaction is either an auction or a trading included in the electronic information” is unclear. It is unclear how it is known that an auction or trading transaction is included in the distributed information and what Applicant intended by this limitation.
 - The limitation “wherein the selecting comprises referencing a definition table that defines providing conditions in accordance with trading prices and transaction types” is unclear. It is unclear if referencing a definition table actually performs a function as it does not pull data from the table, it appears the limitation only refers to looking (i.e. referencing) at the information.

Art Unit: 3626

- The limitation “cross-checking, by a server operated by a service dealer other than a buyer, a seller and an insurer” is unclear; in the other limitations of claim 4, the server is operated by the service dealer other than the buyer. For the purpose of examination, the server will be treated as being operated by the service dealer other than the buyer.
5. With regard to claim 3, the Applicant recites "if the insurance is invalid, or if the buyer...." and "if the insurance is invalid, or if the seller.....". It is unclear what happens when the "if" statements are false.
6. With regard to claim 5, the term “normal” is subjective; what is normal for one, may not be normal for another. In addition, the phrase “based on a discount insurance” is unclear; The Applicant has not clearly claimed what the phrase "based on a discount insurance" refers to, for instance, trading price or final insurance premium.
7. Claims 2 – 3, 5, 10 – 11, and 20 are rejected for the same or similar reasons as claim 4.

Claim Rejections - 35 USC § 101

8. The 35 U.S.C. 101 rejections of claims 2 – 5 and 20 are hereby withdrawn based upon the amendment submitted August 16, 2010.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
10. Claims 4 - 5, 10 – 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiMattina, (U.S. Patent No. 6,405,177) in view of Furusawa et al., herein after Furusawa (U.S. Patent No. 6,934,738).

Art Unit: 3626

In regard to claim 4 (CURRENTLY AMENDED), DiMattina teaches an insurance task processing method comprising:

cross-checking, by a server operated by a service dealer other than a buyer, a seller and an insurer, electronic information distributed within the server between the buyer and the seller with a word table in which a solicitation-related keyword is registered (Figures 1, 3, and 4; column 2, lines 57 – 63; column 3, lines 56 – 62; and column 4, lines 12 – 14) where the Examiner interprets the data regarding the items the purchaser wishes to buy to be a form of a solicitation-related keyword. A form of cross-verifying is performed when the purchase price is verified against the item to be purchased; and

distributing, by the server operated by the service dealer other than the buyer, solicitation-to-insurance information to the buyer, the seller or both, when judged by the server that the solicitation-related keyword is included in the electronic information (column 3, line 56 through column 4, line 21), wherein said distributing comprises: selecting at least one insurer from a plurality of insurers based on registered information that satisfies a providing condition of a trading price and a transaction type indicating whether the transaction is either an auction or a trading included in the electronic information (column 1, lines 35 – 47 where DiMattina discloses an electronic commerce model in which a user can bid to make a purchase at a desired cost, where a bid is equated to an auction), wherein the selecting comprises referencing a definition table that defines providing conditions in accordance with trading prices and transaction types (column 1, lines 35 – 47). DiMattina does not explicitly disclose a definition table, however this feature is disclosed by Furusawa.

Furusawa discloses a method comprising: judging, by the server operated by the service dealer other than the buyer, whether the solicitation-related keyword is included in the electronic information (column 4, lines 21 – 34 where a distributing station associates or defines keywords to a handler program); and distributing the solicitation-to-insurance information of each selected insurer (column 3, lines 13 – 39).

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over DiMattina in view of Furusawa.

Art Unit: 3626

Dimattina is directed to a system for securing business to business internet transactions conducted on-line, where the business may be an insurance product (column 2, lines 2 – 16).

Furusawa is directed to a message processing apparatus that consults a table that defines relationships between handler programs (the handler program files provide a collection of processes to be executed when a message contains key words or information) and key information (column 3, lines 28 – 39).

It would have been obvious to one of ordinary skill in the art to include in the online business transactions of Dimattina the ability to relate key words and information pertinent to the business and defined in a table as taught by Furusawa since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In regard to claim 5 (CURRENTLY AMENDED), DiMattina and Furusawa teach the insurance task processing method of claim 4. DiMattina teaches a method further comprising:

receiving insurance premium information which has been calculated corresponding to a trading price included in the electronic information, based on a discount insurance premium rate (column 5, lines 23 – 26); calculating a sum of the insurance premium indicated by the received insurance premium information and the trading price (column 5, lines 26 – 29); and presenting the calculated insurance premium and the calculated sum to both the buyer and seller (column 4, lines 14 – 17 and column 5, lines 44 – 50), wherein said receiving insurance premium information, said calculating, and said presenting are performed by the server operated by the service dealer other than the buyer (claim 1, where the server is operated by the insurance company).

Computer Readable Medium, System, and Method claims 10, 11, and 20 respectively, repeat the subject matter of claim 4. As the underlying processes of claim 4 has been shown to be fully disclosed by

Art Unit: 3626

the teachings of DiMattina and Furusawa in the above rejection of claim 4; as such, these limitations (10, 11, and 20) are rejected for the same reasons given above for claim 4 and incorporated herein.

11. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiMattina, (U.S. Patent No. 6,405,177) in view of Furusawa et al., herein after Furusawa (U.S. Patent No. 6,934,738) further in view of Dickinson et al., herein after Dickinson (U.S. Patent Number 7,260,724).

In regard to claim 2 (PREVIOUSLY PRESENTED), DiMattina and Furusawa teach the insurance task processing method of claim 4. DiMattina teaches a method wherein said distributing only distributes the solicitation-to-insurance information to the buyer when the buyer has not yet subscribed to insurance (column 3, line 53 through column 4, line 31) where the insurance is offered for the particular transaction, thus the buyer has not subscribed to insurance yet.

Dickinson teaches a method wherein said distributing only distributes the solicitation-to-insurance information to the seller when the seller has not yet subscribed to insurance (column 45, lines 20 – 30) where Dickinson discloses offering insurance to a vendor. As the vendor has not signed or agreed to the policy at the time of the offer, the vendor is considered to not yet have subscribed to insurance.

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over DiMattina in view of Furusawa, further in view of Dickinson.

Dimattina is directed to a system for securing business to business internet transactions conducted on-line, where the business may be an insurance product (column 2, lines 2 – 16).

Furusawa is directed to a message processing apparatus that consults a table that defines relationships between handler programs (the handler program files provide a collection of processes to be executed when a message contains key words or information) and key information (column 3, lines 28 – 39).

Dickinson is directed to a system for performing authentication of a first user to a second user in electronic transactions, such as online purchases and offering a form of security to the vendors based on the risk the vendor is willing to take (column 45, lines 20 - 30).

Art Unit: 3626

It would have been obvious to one of ordinary skill in the art to include in the online business transactions of DiMattina and the ability to relate key words and information pertinent to the business and defined in a table as taught by Furusawa, a system for providing security and/or authentication for online transactions as taught by Dickinson since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In regard to claim 3 (PREVIOUSLY PRESENTED), DiMattina, Furusawa, and Dickinson teach the insurance task processing method of claim 2. DiMattina teaches a method wherein said distributing distributes the solicitation-to-insurance information to the buyer even when the buyer has previously subscribed to insurance, if the insurance is invalid, or if the buyer has experienced an encounter with an accident related to electronic commerce in the past (column 3, line 58 through column 4, line 3) where DiMattina does not give any restrictions on when the insurance information is distributed, thus it would still past (column 45, lines 20 – 30).

The motivation to combine the teachings of DiMattina, Furusawa, and Dickinson is discussed in the rejection of claim 2, and incorporated herein.

Response to Arguments

12. Applicant's arguments filed August 16, 2010 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed August 16, 2010.

Rejection of claims 2 – 5, 10 – 11, and 20 under 35 USC § 112, Second Paragraph

The rejection of claims 2 – 5, 10 – 11 and 20 under 35 USC § 112, Second Paragraph are maintained. The rationale for the rejection is discussed above. In addition, a new 35 USC § 112, second paragraph rejection has been added regarding the server operated by a service dealer and is discussed above.

Rejection of claims 2 – 5 and 20 under 35 USC § 101

The 35 U.S.C. 101 rejections of claims 2 – 5 and 20 are hereby withdrawn based upon the amendment submitted August 16, 2010.

Rejection of claims 2 – 5, 10 – 11, and 20 under 35 USC § 103

With regard to claim 4, the Applicant argues that none of the art of record, alone or in combination, teach a "selecting at least one insurer from a plurality of insurers," the term "bid" as used in references does not refer to an auction, and neither DiMattina or Furusawa teach a definition table. The Examiner respectfully disagrees.

The examiner respectfully submits DiMattina teaches selecting at least one insurer from a plurality of insurers. DiMattina discloses business to business models where a site acts as a broker between someone wanting a product and service and providers offering the product and service. It is implied that a user would select just one provider (i.e. insurer) from the providers offering the service based on the bids submitted by the providers of the service (column 1, lines 35 – 47). Thus, Applicant's arguments are not persuasive.

The Examiner respectfully submits the term bid, as defined by DiMattina, is appropriate. A request for proposal (RFP) is a request in which vendors bid to obtain a customer's business, thus the bidding process takes the form of an auction, as an auction is a sale to the highest bidder (or the lowest bidder in the case of a reverse auction, where the vendor's bids decrease and the contract or service typically goes to the lowest bidder). For example, see www.businessdictionary.com.

The Examiner respectfully submits Furusawa teaches a definition table. Furusawa discloses a definition table which defines key words and information. This information is associated with a handler program, which provides programs to be executed when a message contains keywords or information (column 3, lines 28 – 39). Thus it would be obvious that the table disclosed by Furusawa could include the insurance keywords and information.

Art Unit: 3626

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 3:30 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Morgan can be reached on 571-272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. K. R./
Examiner, Art Unit 3626

//Neal R Sereboff//
Examiner, Art Unit 3626